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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/886,886	06/21/2001	Ken Ilkka	7104/81880	6121

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EXAMINER

PARKER, FREDERICK JOHN

ART UNIT PAPER NUMBER

1762

DATE MAILED: 07/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/886,886

Applicant(s)

ILKKA, KEN

Examiner

Frederick J. Parker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Specification

The amendments in response to the Objections to the Specification of the Previous Office Action are acknowledged and appreciated, and the Examiner withdraws the objections.

1. The amendment filed 6/3/05 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: in [0008,0016,0017] insertion of "by volume" is New Matter because it was not in the original filing or based upon external evidence showing it is not New Matter.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Objections

The previous claim objection to claim 2 is moot in view of its cancellation.

2. Claim 1 is objected to because of the following informalities: last line "in" should be "is". Appropriate correction is required.

Claim Rejections - 35 USC § 112

The amendments in response to the 35 USC 112 rejections of the Previous Office Action are acknowledged and appreciated, and the Examiner withdraws the rejections, except as necessitated by amendment.

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 15,16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant

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art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 15; lines 12-13 require visual information about an aspect of operation of the vehicle, and further lines 14-17 require ink agitation so the formed image is “generally evenly mixed to be...been agitated so the image is maximized. NO such limitations are present in the original filing, nor have Applicants cited page/ line citations in Remarks to demonstrate support.

In claim 16, the basis of percentages “by volume” are not present in the original filing, nor have Applicants cited page/ line citations in Remarks to demonstrate support.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 15 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claim 15 is vague and indefinite because on lines 8-9 the image formed is “visible to a user of a motor vehicle...part” which excludes non-users which is confusing since it is unclear how users, but not non-users, can see the image; the passage is further unclear because the image would appear to be visible to anyone regardless of where it is located in the car (in the engine, trunk, etc) as long as the part is made visible to any sighted viewer. Lines 12-13 are confusing because since any inked image provides “visual information”, the intended meaning of the required information is unclear, and further the meaning of “aspect of operation” is unclear; last paragraph, the relative and

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ambiguous terms “generally” or “general” fail to precisely and definitively describe the intended mixing, extent, and maximization.

Claim Rejections - 35 USC § 103

The amendments in response to the 35 USC 103 rejections of the Previous Office Action are acknowledged, and the Examiner withdraws the rejections which are replaced with the new rejections below necessitated by amendment.

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claims 15-17, 19-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pryor et al US 4269874 in view of Alden US 4538560 in combination, or optionally in view of Nicholl US 3011916.

The “Background...” section of Pryor et al teaches that in manufacturing, e.g. of automotive parts (encompassing any auto part materials), the parts are “routinely marked” with indicia without limitation to signify good versus bad parts, part type, shift when made, etc which are visible to any sighted viewer. Marking has traditionally been carried out by means including stamp-type ink/ paint markers (inherently possessing raised ink printing portions) in which ink wets the stamp and is transferred onto the part (col. 1, 8-31). Applying the raised inked portions to a part plated with chrome is not taught. However, Alden teaches chrome plated engine valve covers, the chrome plating being applied to brighten the appearance of the engine and enhance worth of the automobile (col. 1, 13-17; col. 2, 46-48). Fabrication is by stamping (col. 2/ 7-12) which is a form of molding since a molding form is required on which the metal part is stamped. While marking the valve cover via ink stamping is not taught, Pryor et al teaches this to be

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routine for automobile parts, and hence the skilled artisan would have found it obvious to apply such markings via ink stamping to signify quality, part type, etc for a specific automotive part, per claim 6. While agitating the ink is not expressly cited, clearly, application of ink to a stamp and subsequent transfer of the ink into the part would agitate ink, agitation conventionally meaning "the action of moving". The skilled artisan applying ink would have understood that printing ink is a suspension of a pigment in a liquid vehicle, so that agitation of the ink to achieve a uniform suspension prior to inking and printing would have been an obvious step. Although the Examiner believes further support unnecessary because agitation of inks is notoriously well-known, Nicholl is optionally introduced where on col. 2 the need to keep ink dispersed by agitation during use, expressly citing stamping, is disclosed. Since Applicants' claims merely require agitation, the limitation would have been obvious and met by either alternative.

The size of ink batches, stamp forming time, and exact composition would have been determined by routine experimentation for any end-use product, per claims 16,17,19.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to carry out the ink stamping method of Pryor et al on the chrome plated part of Alden using agitation of ink during use as is known in the art, or optionally as disclosed by Nicholl, because automotive parts are "routinely marked" to signify good versus bad parts, part type, shift when made, etc by ink stamping.

2. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pryor et al US 4269874 in view of Alden US 4538560 and optionally Nicholl and further in view of Reinke et al US 3170393.

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Pryor, Nicholl, and Alden are cited for the same reasons above. Heating the printed object is not cited. However, Reinke et al teaches the concept of printing inks onto substrates including metal, followed by drying at any suitable temperature between 200-325F (encompassing claim 18) using a suitable heating element to hasten the drying/ curing process of the ink. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Pryor et al in view of Alden and optimally Nicholl by heating the printed metal article as taught by Reinke et al to hasten the drying/ curing process of the ink, and thereby improve the efficiency of the metal printing process. Specific heating times and temperatures would have been determined by the skilled artisan by routine experimentation and/ or readily available technical information for any specific ink and printing process.

Response to Arguments

Applicants argue Pryor does not teach nor suggest the ink image is visible to the viewer of the motor vehicle, a phrase rejected under 35 USC 112 above. The Examiner's position is that any inked image/ indicia would be visible to any sighted person even if an effort is required to view other image. Applicants' example of an ink image on a decorative door molding is not commensurate with the scope of the claims which fail to require such a limitation. Pryor is not limited as to printed images and would encompass a key icon. All information provided by Pryor is "visual information" to signify quality, part type, etc which clearly relates to "an aspect of operation" of the vehicle.

Pryor teaches ink marking of vehicle parts is routine and conventional, and Alden teaches auto parts are routinely chrome plated to enhance value of the vehicle, thereby providing

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motivation since such marking to signify part type, quality, etc is directly related to providing enhanced value of the vehicle.

The issue of mixing of the ink and degree of mixing during use is well-known in the art; however, to rebut applicant's arguments and meet the claim limitations as now written, this issue is dealt with in detail under the 35 USC 103 rejection above⁴.

Applicants amendments and arguments are not persuasive, and the rejections are maintained.

3. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

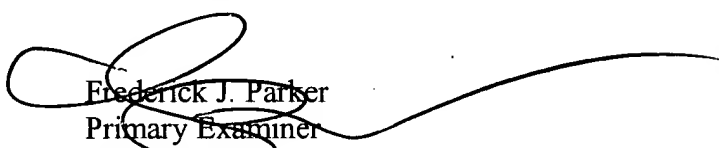
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frederick J. Parker whose telephone number is 571/ 272-1426. The examiner can normally be reached on Mon-Thur. 6:15am -3:45pm, and alternate Fridays.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571/272-1423. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Frederick J. Parker
Primary Examiner
Art Unit 1762

fjp